

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Edward J. Stashluk, Jr., et al.
Serial No.: 10/775,368
Filing Date: February 10, 2004
Group Art Unit: 3689
Examiner: Thuy-Vi Thi Nguyen
Confirmation No.: 9915
Title: COMPUTER GENERATED MERCHANDISE RETURN
LABELS WITH RULES-BASED CODING

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

REPLY BRIEF

Pursuant to 37 C.F.R. § 1.193, Appellants respectfully file this Reply Brief in response to the Examiner's Answer dated September 15, 2011.

ARGUMENTS

Appellants filed an Appeal Brief on June 20, 2011 (“*Appeal Brief*”), explaining clearly and in detail why the rejections of the claims in the final Office Action dated January 20, 2011 (“*Office Action*”), are improper. While Appellants appreciate the Examiner’s thoughtful consideration of this case and the Examiner’s response in the Examiner’s Answer dated September 15, 2011 (“*Examiner’s Answer*”), Appellants respectfully submit that these rejections continue to be improper and should be reversed by the Board.

I. Claims 1-5, 7-22, 24-28, and 30-35 are allowable over the *Tsunenari-Savino-Official Notice* combination

In the *Appeal Brief*, Appellants’ argued that the *Tsunenari-Savino-Official Notice* is deficient with respect to Appellants’ claim at least because the cited references do not disclose this combination of claim elements recited in Appellants’ claims. Additionally, Appellants argued that one of ordinary skill in the art at the time of Appellants’ invention would not have been motivated to make the proposed combination to result in Appellants’ claim language.

A. The Proposed *Tsunenari-Savino-Official Notice* combination does not disclose, teach, or suggest a return shipping label that “complies with shipping label specifications of the choice of carrier” and includes both “the first machine readable code not associated with the carrier” and “a second carrier-specified machine readable code also present on the shipping label”

First, Appellants argued that the proposed *Tsunenari-Savino-Official Notice* combination does not disclose, teach, or suggest a return shipping label that “complies with shipping label specifications of the choice of carrier” and includes both “the first machine readable code not associated with the carrier” and “a second carrier-specified machine readable code also present on the shipping label,” as recited in independent Claim 1. Specifically, Appellants demonstrated that while *Tsunenari* discloses a typical carrier shipping label (*Tsunenari*, paragraphs 62 and 81), *Savino* does not at all relate to a shipping label and instead relates to a “packing slip” or something similar to a packing slip. (*Savino*, Column 1, lines 36-50: Figures 3 and 5).

In the *Examiner's Answer*, the Examiner states that *Tsunenari* discloses a shipping label that complies with specifications of choice of carrier and that *Savino* discloses a shipping label having a machine readable barcode for coordinating shipping and receiving information. (*Office Action*, pages 16-17). It is the Examiner's position that “[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to provide the method of generating shipping label contains the readable bar code used by carrier of *Tsunenari et al* to include a machine readable code which represents customer address and identification of the transaction as taught by *Savino et al* for improving the coordinating shipping and receiving information between supplier/merchant {see *Savino et al* col. 1, lines 34-55}.” (*Office Action*, page 17). Appellants respectfully disagree.

As previously demonstrated, *Tsunenari* discloses nothing more than a typical carrier-issued shipping label. (*Tsunenari*, paragraphs 62 and 81). In contrast, the label of *Savino* has none of the usual features of a shipping label and instead amounts to a scannable packing slip that is placed inside the package. (*Savino*, Figure 3). Accordingly, even when the disclosures of *Tsunenari* and *Savino* are considered in combination, Appellants respectfully submit that result is a package having a first shipping label with a carrier-specific bar code (such as that disclosed in *Tsunenari*) and a second packing slip type label with an additional machine readable code (such as that disclosed in *Savino*). It remains Appellants' position that neither reference nor their proposed combination discloses a return shipping label that “complies with shipping label specifications of the choice of carrier” and includes both “the first machine readable code not associated with the carrier” and “a second carrier-specified machine readable code also present on the shipping label,” as recited in Claim 1.

In the *Examiner's Answer*, the Examiner states that “the return shipping label for shipment from the customer to returns center’ is considered as intended use limitation and does not provide the distinction in structure and function between the claimed ‘shipping label’ and the label disclosed in *Tsunenari* and *Savino*.” (*Office Action*, page 19). Appellants respectfully disagree. Appellants' Claim 1 recites “a set of stored business rules to determine coding to be printed on a return shipping label” and then “using the computer operated by the merchant . . . to generate a first machine readable code for the return shipping label for shipment from the customer to the returns center. . . .” Appellants' Claim 1 further recites “using the computer operated by the merchant . . . to format the return shipping label, such

that the return shipping label contains the first machine readable code and complies with shipping label specifications of the choice of carrier, the first machine readable code not associated with the carrier and in addition to a second carrier-specified machine readable code also present on the shipping label." As such, Appellants' claim clearly recite a carrier-compliant return shipping label to be used in shipping a package from the customer to the returns center. Furthermore, Appellants' claim does recite specific structure and functional distinction between the claimed "shipping label" and the labels disclosed in *Tsunenari* and *Savino*.

The M.P.E.P. provides that "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). To the extent that the Examiner dismisses Applicants' claim language as being related to "intended use", Appellants respectfully submit that the Examiner is improperly failing to give credence to the limitations specifically recited in Appellants' claim. Additionally, without conceding that Applicants' claim language recites an intended use, the Examiner provides no support for the Examiner's contention that an intended use recited in a claim must result in a structural difference between the claimed invention and the prior art. In fact, the M.P.E.P. merely states:

As a general matter, the grammar and intended meaning of terms used in a claim will dictate whether the language limits the claim scope. Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim:

- (A) statements of intended use or field of use,
- (B) "adapted to" or "adapted for" clauses,
- (C) "wherein" clauses, or
- (D) "whereby" clauses.

M.P.E.P. § 2106. In this instance, Applicants' claim language does not suggest or make optional a step. Rather Applicants' claim language clarifies that in Applicants' step of "using the computer . . . to generate a first machine readable code for the return shipping label for shipment from the customer to the returns center," the computer generates a shipping label that 'complies with shipping label specifications of the choice of carrier" and includes both

“the first machine readable code not associated with the carrier” and “the second carrier specified machine readable code also present on the shipping label.” Thus, rather than reciting an intended use, Applicants’ claim language recites structural features of the carrier compliant shipping label. Because neither reference nor their proposed combination discloses a return shipping label that “complies with the shipping label specifications of the choice the carrier” and includes both “a first machine readable code” and a “second carrier-specified machine readable code,” Appellants respectfully submit that Claim 1 is allowable over the proposed *Tsunenari-Savino-Official Notice* combination.

Furthermore, Appellants respectfully submit that it would not have been obvious to one of ordinary skill in the art at the time of Appellants’ invention to modify or combine the carrier-issued shipping label of *Tsunenari* to include the bar code of *Savino*. The Examiner states that such a modification would have been obvious “for improving the coordinating shipping and receiving information between supplier/merchant {see *Savino et al* col. 1, line s34-55}.” (*Examiner’s Answer*, page 17). However, it appears that the Examiner has merely proposed an alleged advantage of combining *Tsunenari* with *Savino* (an advantage which Appellants do not admit could even be achieved by combining these references in the manner the Examiner proposes). While the Examiner has cited a portion of *Savino* that touts an advantage of having a packing slip that includes the scannable single bar code, the Examiner has not pointed to any portions of the cited references that would teach, suggest, or motivate one of ordinary skill in the art at the time of invention to include the scannable single bar code disclosed in *Savino* on the carrier-issued shipping label disclosed in *Tsunenari*. In other words, the alleged advantage of the single scannable bar code of *Savino* does not provide an explanation as to: (1) why it would have been obvious to one of ordinary skill in the art at the time of Appellants’ invention (*without using Appellants’ claims as a guide*) to modify the particular techniques disclosed in *Tsunenari* with the disclosure in *Savino*; (2) how one of ordinary skill in the art at the time of Applicants’ invention would have actually done so and still maintained compliance with the carrier-issued label of *Tsunenari*; and (3) how doing so would purportedly meet the limitations of Claim 1. Indeed, if it were sufficient for Examiners to merely point to a purported advantage of one reference and conclude that it would have been obvious to combine or modify that reference with other references simply based on that advantage (which, as should be evident from the case law discussed above, it

certainly is not), then virtually any two or more references would be combinable just based on the fact the one reference states an advantage of its system.

Appellants respectfully submit that the Examiner's attempt to modify or combine *Tsunenari* with *Savino* appears to constitute the type of impermissible hindsight reconstruction of Applicants' claims, using Applicants' claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases. Accordingly, since the prior art fails to provide the required teaching, suggestion, or motivation to combine *Tsunenari* with *Savino* in the manner the Examiner proposes, Appellants respectfully submit that the Examiner's conclusions set forth in the Office Action do not meet the requirements set forth in the M.P.E.P. and the governing Federal Circuit case law for demonstrating a *prima facie* case of obviousness. Appellants respectfully submit that the rejection must therefore be withdrawn.

For at least these reasons, Appellants respectfully submit that the rejection of Claim 1, together with Claims 2-5, 8-11, and 33-35 that depend from Claim 1, are improper and should be withdrawn. For analogous reasons, Appellants also request that the rejection of independent Claims 14 and 28, together with Claims 15-16, 19-22, and 25-27 that depend on Claim 14 and Claims 29-32 that depend on Claim 28, are also improper and should be withdrawn.

B. The Proposed *Tsunenari-Savino-Official Notice* Combination is Improper

Second, Appellants argued that the proposed *Tsunenari-Savino-Official Notice* combination is improper at least because *Savino* teaches away from the proposed combination. Specifically, Appellants demonstrated that *Savino* describes a "single bar code shipping label." (*Savino*, Column 2, lines 7-10, emphasis added). Throughout, *Savino* praises a label that includes a single bar code. According to *Savino*, "if for example, nine bar codes are provided with each packing slip, it will typically take about one minute to scan-in each nine-block label." (*Savino*, Column 1, lines 43-45). As another example, *Savino* explains that "several bar codes increases the likelihood that one or more of the bar codes provides incorrect information." (*Savino*, Column 1, lines 48-50). With regard to previous packing slips, *Savino* discloses that a "drawback is that the packing slip supplied with each

purchase order typically includes several bar codes that are scanned by the customer if equipped with an automated receiving system." (*Savino*, Column 1, lines 36-38). Thus, *Savino* actually teaches away from a shipping label that includes more than one bar code. As a result, *Savino* teaches away from modifying the carrier-specific bar code of *Tsunenari* to include an additional merchant-specific bar code.

In response, the Examiner answers that:

... SAVINO discloses a system of employing a single bar code provided on a shipping label for coordinating shipping and receiving information between supplier and customer, whereby data value in the single bar code represents a purchase and shipping information of a purchase order such as customer name and address, packing slip number, customer purchase order number and etc {see figures 4-5, at least col. 2, lines 7-190; col. 3, lines 34-54, col. 4, lines 24-35}. This single bar code is scanned and used by the supplier or customer for coordinating shipping and receiving information, but does not provide for the actual delivery. There is no specific provision for postage, package weight or other data typically employ by a carrier for delivery (see SAVINO col. 1, lines 59-67; col. 2, lines 1-6}. Thus, the single bar code of SAVINO would not typically be the only bar code on the package being delivered. The package being delivered would have obviously also contain another machine readable code that being used by a carrier for delivery.

(*Examiner's Answer*, pages 21-22). Thus, it is the Examiner's position that, because *Savino* does not include a carrier-related bar code, it would be obvious to combine the disclosure of *Savino* with the disclosure of *Tsunenari* because two bar codes would "obviously" be necessary for delivery. Appellants respectfully disagree.

Initially, Appellants note that the reason that the label of *Savino* does not include carrier information or any provisions for postage, package weight or other data employed by a carrier is because the label of *Savino* is not a shipping label. As discussed above, the label disclosed in *Savino* has none of the usual features of a shipping label and instead amounts to a scannable packing slip that is placed inside the package. (*Savino*, Figure 3). Because the packing slip label disclosed in *Savino* is placed inside the package, it remains Appellants' position that the objectives of such a label (i.e., linking the package to a purchase order) is very different from the objectives of the carrier-issued shipping label of *Tsunenari* (i.e., to enable delivery of the package). As such, Appellants respectfully submit that the Examiner's

attempt to modify or combine *Tsunenari* with *Savino* constitutes the type of impermissible hindsight reconstruction of Applicants' claims, using Applicants' claims as a blueprint, that is specifically prohibited by the M.P.E.P. and governing Federal Circuit cases.

Moreover, the Examiner's conclusion that the combination is proper ignores the fact that *Savino* explicitly teaches away from a label including more than one bar-code. The Federal Circuit has held that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F. 2d 1540, 220 U.S.P.Q. 303 (Fed. Circ. 1983), *cert. denied*, 469 U.S. 851 (1984); M.P.E.P. § 2141.02. Thus, it should not be ignored that *Savino* repeatedly touts the advantages of a single-bar code and explicitly describes that a packing slip having “several bard codes” is a drawback and should be avoided. (*Savino*, Column 1, lines 36-38, 43-45, and 48-50). It remains Appellants' position that the combination is improper at least because *Savino* explicitly teaches away from a label having multiple bar codes.

For at least these additional reasons, Appellants respectfully submit that the rejection of Claim 1, together with Claims 2-5, 8-11, and 33-35 that depend from Claim 1, are improper and should be withdrawn. For analogous reasons, Appellants also request that the rejection of independent Claims 14 and 28, together with Claims 15-16, 19-22, and 25-27 that depend on Claim 14 and Claims 29-32 that depend on Claim 28, are also improper and should be withdrawn.

II. Claims 7 and 24 are patentable over the proposed *Tsunenari-Savino-Official Notice* combination

In the *Appeal Brief*, Appellants argued that the proposed *Tsunenari-Savino-Official Notice* combination does not disclose, teach, or suggest “the customer data represents customer preferences, at least one customer preference comprising a customer-selected choice of carrier” and that the method further includes “using the computer . . . to format the return shipping label as required by the customer-selected choice of carrier.” Specifically, Appellants demonstrated that *Tsunenari*, as relied upon by the Examiner, merely discloses that the Web server automatically selects the most economical carrier. There is no disclosure in *Tsunenari* of “customer data [that] represents customer preferences” wherein “at least

one customer preference compris[es] a customer-selected choice of carrier,” as recited in Claim 7. Likewise, *Tsunenari* does not disclose, teach, or suggest “using the computer . . . to format the return shipping label as required by the customer-selected choice of carrier,” as recited in Claim 7.

In the *Examiner’s Answer*, the Examiner states that “customer preference data (customer’s address) is a factor in choosing the selected carrier as shown in figure 10i, 10J, and 11B par. 0092.” (*Examiner’s Answer*, page 23). However, Appellants’ Claim 7 specifically recites that “the customer data represents . . . a customer-selected choice of carrier” and that the return shipping label is formatted “as required by the customer-selected choice of carrier.” A system that accesses customer data that identifies a customer-selected choice of carrier and then formats a bale according to the customer-selected choice of carrier is distinguishable from the system of *Tsunenari*, which merely selects the most economical carrier.

For at least these reasons, Appellants respectfully submit that the rejection of Claim 7 is improper and should be withdrawn. For analogous reasons, Appellants also submit that the rejection of Claim 24 is also improper and should be withdrawn.

III. Claims 12-13 and 17-18 are patentable over the proposed *Tsunenari-Savino-Official Notice* combination

In the *Appeal Brief*, Appellants argued that the proposed *Tsunenari-Savino-Official Notice* combination does not disclose, teach, or suggest “using the computer associated with the merchant or the specialized return center to format the return shipping label to include a carrier center location closest to the merchant or the specialized returns center as the shipping destination such that the package is delivered to the carrier center location and picked up by the merchant or the specialized returns center.” Appellants also argued that the proposed *Tsunenari-Savino-Official Notice* combination does not disclose, teach, or suggest that the “carrier center location closest to the merchant or the specialized returns center is a bulk mail center.” Specifically, Appellants demonstrated that *Tsunenari* merely discloses that the Web server automatically selects the most economical carrier. (*Tsunenari*, paragraph 61).

In response, the Examiner states that *Tsunenari* teaches that “[t]he return shipping label is going to the centralized facility which does not appear to be the merchant location as

shown in *Tsunenari* paras. 0093, 0121 and figures 10i, 11B (step 1137) and figure 15 . . .” (*Examiner's Answer*, page 26). However, Appellants respectfully submit that the centralized facility of *Tsunenari* is not a carrier center location that is closest to the merchant or the returns center. Rather, *Tsunenari* merely discloses that the “Web server selects a product return destination for the consumer product . . . in accordance with the product type sending the product to a facility at which it may be processed.” (*Tsunenari*, paragraph 60). As an example, *Tsunenari* discloses that “in the case of a laser toner cartridge being returned fro recycling, a destination will be chosen at which the recycling can be done.” (*Tsunenari*, paragraph 60). Additionally, *Tsunenari* discloses that the designation may be “further refined in accordance with the location of the consumer, selecting whatever suitable destination is closest to the consumer in order to minimize shipping costs.” (*Tsunenari*, paragraph 60). Thus, *Tsunenari* discloses that the final destination is chosen based on the type of product or the location of the customer. *Tsunenari* does not disclose that the final destination printed on the return shipping label is that of a “carrier center location,” as recited in Claim 12. Likewise, *Tsunenari* does not disclose, teach, or suggest “format[ting] the return shipping label to include a carrier-center location closest to the merchant or the specialized returns center as the shipping destination such that the package is delivered to the carrier center location and picked up by the merchant or the specialized returns center,” as recited in Claim 12.

The Examiner further states that the “the mere ownership of this facility either by the carrier or the merchant does not seem to impact the manipulative action of “formatting the return shipping label to include a carrier center location”. (*Examiner's Answer*, pages 26-27). Appellants respectfully disagree. Appellants claim affirmatively recites “accessing carrier center location data” and then “using the computer . . . to format the return shipping label to include a carrier center location closest to the merchant or the specialized returns center . . .” *Tsunenari* does not disclose either operation. Appellants respectfully submit that Applicants' claim is patentably distinct from a system such as *Tsunenari* that specifies that the label includes a shipping destination that is not associated with the carrier.

For at least these reasons, Appellants respectfully submit that the rejections of Claims 12-13 are improper and should be withdrawn. For analogous reasons, Appellants also submit that the rejections of Claims 17-18 are also improper and should be withdrawn.

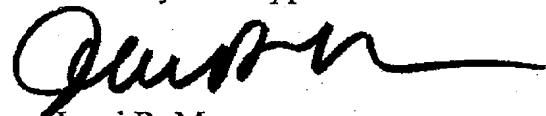
CONCLUSION

Appellants have demonstrated that the present invention, as claimed, is clearly distinguishable over the prior art cited by the Examiner. Therefore, Appellants respectfully request the Board to reverse the final rejections and instruct the Examiner to issue a Notice of Allowance with respect to all pending claims.

No fees are believed due; however, the Commissioner is authorized to charge any additional fees or credits to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

Respectfully submitted,

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